



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 16

THE H.T. THAN LAW GROUP
1010 WISCONSON AVE., N.W.
SUITE 560
WASHINGTON, DC 20007

COPY MAILED

JUL 12 2004

OFFICE OF PETITIONS

In re Application of :
Thuy Diem Pham :
Application No. 09/866,261 :
Filed: May 25, 2001 :
Title of Invention: :
VIRAL DETECTION SYSTEM :
:

This is a decision on the Petition for Reconsideration Under 37 CFR § 1.182, or In The First Alternative, Petition to Revive Under 37 CFR § 1.137(a) for Unavoidable Abandonment, or In The Second Alternative, Petition to Revive Under 37 CFR § 1.137(b) for Unintentional Abandonment, filed May 21, 2004 (Certificate of Transmission dated May 17, 2004).

This Petition Under 37 CFR § 1.182 is hereby **dismissed**.

This Petition Under 37 CFR § 1.137(a) is hereby **dismissed**.

This Petition Under 37 CFR § 1.137(b) is hereby **granted**.

Background

The above-identified application became abandoned for failure to timely and properly respond to the Notice to File Corrected Application Papers (hereinafter "Notice"), mailed August 2, 2002. The Notice set a two (2) month period for reply, and required a substitute specification in compliance with 37 CFR 1.52. Extensions of time were available under 37 CFR 1.136(a).

On September 9, 2003, the Office received a coversheet entitled "Response to Notice to File Corrected Application Papers" (hereinafter "Coversheet"). The Coversheet stated that the substitute specification was attached; however, no new substitute specification was located among the application papers. The Coversheet included a Certificate of Mailing; however, the Certificate of Mailing certifies that "this paper is being deposited . . . on February 25, 2002." The Coversheet

and Certificate of Mailing are signed and dated September 6, 2002.

Because no substitute specification in response to the Notice was received, the application became abandoned for failure to timely and properly reply to the Notice.

Applicant filed a petition on December 15, 2003, requesting withdrawal of the holding of abandonment. In support of that request, Applicant argued that corrected application papers were timely filed on September 6, 2002, and included a return-receipt postcard. Applicant further stated that status inquiries were filed on January 23, 2003 and May 21, 2003 respectively. In response to the second status inquiry, Applicant received correspondence from Technology Center Art Unit 1700 notifying Applicant of the projection that the application will be examined three (3) to six (6) months from the mail date of the correspondence.

That petition was dismissed in a Decision mailed April 21, 2004. The Decision dismissing the petition informed applicant that the Certificate of Mailing contained a discrepancy between the date that Applicant certified as the mail date, and the date the correspondence was signed. The Certificate of Mailing certified that "this paper is being deposited . . . on February 25, 2002." The date Applicant sought to rely upon was September 9, 2002. As such, the procedure described in this section was not followed, and the Certificate of Mailing was improper and could not be relied upon to establish that the substitute specification was timely filed.

Applicant was also advised that the return-receipt postcard did not list a substitute specification. Thus, while applicant's postcard receipt provided evidence of receipt of a Response to Notice to File Corrected Application Papers and a Request for Refund, and papers entitled Response to Notice to File Corrected Application Papers and a Request for Refund were among the papers located in the file, the return-receipt postcard failed to demonstrate that a substitute specification was included among the papers filed on September 9, 2002.

Applicant could not rely on his Certificate of Mailing or his return-receipt postcard as evidence of timely filing of the

substitute specification. Accordingly, the petition was dismissed.

The instant Petition for Reconsideration Under 37 CFR § 1.182

Applicant files the instant petition for reconsideration and argues that the printing of the date of February 25, 2002 in the Certificate of Mailing is an obvious typographical error. However, applicant may not rely upon 37 CFR 1.8 if Applicant did not abide by 37 CFR 1.8. The rule is clear. The benefit of 37 CFR 1.8 may be obtained where "[t]he correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission." Here, Applicant argues that the date of deposit or transmission was incorrect, but that he is nonetheless entitled to the benefit of the rule. This Office does not agree.

Applicant also avers that the postcard was sufficiently itemized. Applicant avers that the Office's own practices militate in favor of a liberal reading of the items listed on the return-receipt postcard. Applicant notes that the transmittal form, PTO Form SB/21 lists as among the enclosures that may be sent to this Office, "Response to Missing Parts/Incomplete Application". Applicant avers that he was merely following the logic and format of this Office. Applicant is advised that there are myriad responses that may be filed in response to a Notice of Missing parts, and myriad responses that may be filed in response to a Notice of Incomplete Responses. Applicant agrees that the Transmittal Form lists a number of responses that can be sent to this Office. (Emphasis supplied). The list is not all-inclusive and too numerous to include on the Transmittal Form. This Office disagrees with Applicant's assertion that a Response to Notice to File Corrected Application Papers into components is not required by the Manual for Patent Examining Procedure ("MPEP") § 503. As iterated in the Decision dismissing petition, mailed April 21, 2004,

The MPEP provides that

The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard 'a complete application' or 'patent application' will not serve as a proper receipt

for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee[] or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portions of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard.

MPEP § 503

In this instance, the Response to Missing Parts/Incomplete Application is analogous to the listing on the postcard 'a complete application' or 'patent application', and will not serve as a proper receipt for each of the required components of the Response required. Again, a response may include myriad items, and the postcard will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard.

Applicant argues three additional reasons in support of the instant petition. The first is that, in response to a second status inquiry, the Customer Service Office in Technology Center 1700 mailed Applicant a letter projecting examination of the application in three to six months. Applicant argues that a reasonable person must conclude that the Substitute Specification must have arrived and satisfied the requirements of the Notice. This conclusion incorrectly assumes that the author of the letter examined the application file, found the Substitute Specification, and reviewed the Substitute Specification for compliance with the Notice. In fact, the letter was more in accord with a form letter informing Applicants of the ordinary course of examination. Moreover, the Notice was initiated in the Office of Initial Patent Examination, and it is there that the response was required to be filed, and there that compliance with the Notice would be determined.

Applicant's second additional reason is that, in a telephone conversation with the undersigned, I noticed that there were staple holes in the upper left of the Response to Notice, indicating that at least some papers had been removed from the first page of the Response to the Notice. Applicant is advised that the Office file is the official record of the papers filed in this application. The issue here is the Substitute Specification, which has not been located among the application

papers in the Office file. The burden is on Applicant to demonstrate that the Substitute Specification was timely filed.

Applicant's third additional reason is that equity dictates withdrawal of the holding of abandonment. Applicant is again advised that the burden is on the Applicant to demonstrate that the Substitute Specification was timely filed. Applicant's failure to comply with 37 CFR 1.8 and the MPEP 503 are not extraordinary situations under 37 CFR 1.183 requiring justice.

As iterated in the Decision mailed April 21, 2004, there are three ways in which this Office will consider correspondence timely filed. Applicant has failed to comply with any of those three methods.

The Petition to Revive Under 37 CFR § 1.137(a)

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply (unless previously filed), which may be met by the filing of a notice of appeal and the requisite fee; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance, or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c); (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

Applicant lacks item (3) above. In order to determine whether the delay was unavoidable, the courts have adopted a "reasonably prudent person" standard. The courts have provided that:

[t]he word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to

rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Applicant is further advised that the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987).

Specifically, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

Applicant has failed to demonstrate that the delay was unavoidable. It is the conclusion of this Office that a reasonable person in relation to their most important business would have complied with either 37 CFR 1.8 or MPEP 503.

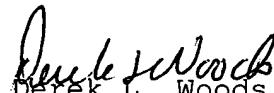
The Petition to Revive Under 37 CFR § 1.137(b)

With the instant petition, Petitioner has satisfied the requirements of a grantable petition under 37 CFR 1.137(b). The reply to the August 2, 2002 Notice is filed with the instant petition. Accordingly, the petition is granted.

Deposit account 50-1980 has been charged \$55.00 for the petition under 37 CFR 1.137(a), and \$665.00 for the petition under 37 CFR 1.137(b).

This application is being forwarded to the Office of Initial Patent Examination for continued processing in due course.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 305-0014.


Derek L. Woods
Petitions Attorney
Office of Petitions